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REMARKS/DISCUSSION OF ISSUES

By this Amendment, Applicants cancel the unelected claims 14-21 without disclaimer or prejudice against subsequent prosecution, for example in a divisional patent application. Applicants cancel these claims simply to put this case in a better position for Appeal should the pending rejections be maintained after careful consideration of the arguments and Remarks below. Applicants also add new claims 29-35.

Claims 1-13 and 22-35 are pending in the application.

The Examiner is respectfully requested to state whether the drawings are acceptable.

The undersigned attorney for Applicants thanks the Examiner's Supervisor, Emmanuel Moise for the courtesy of a very brief telephonic discussion on Friday 12 May 2006. As a result of this discussion, the undersigned attorney understands that the Examiner refused to consider Applicants' statement in the Response to the Final Office Action filed on 18 April 2006 that both the present application and Epstein "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person," because he deemed this to be "new evidence" presented after a Final rejection. Examiner Moise explained that such a statement would be properly considered in an Amendment accompanying a Request for Continued Examination (RCE). Thus, Applicants are filing an RCE and attaching this Amendment to that RCE so that this "evidence" will be considered now.

Reexamination and reconsideration are respectfully requested in view of the following Remarks.

35 U.S.C. § 112, First Paragraph

The Office Action rejects claims 1-13 and 22-28 under 35 U.S.C. § 112, first paragraph.

Applicants traverse those rejections for at least the following reasons.

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The Office Action states that the Specification does not provide adequate detail as to how the invention works.

However, there is no requirement under 35 U.S.C. § 112, first paragraph that a specification provide adequate detail as to how a claimed invention "works." Indeed, even though not the case here, it is well established that an inventor is entitled to a patent even if the inventor himself cannot explain how an invention works, so long as he can and does explain how to make and use the invention. Here, Applicants have provided extended detail as to how to make and use the apparatus as claimed in claims 22-28, and the methods of claims 1-13.

It is noted that the Office Action further states that the specification does not explain "how the sequences presented on the screen are invisible to someone viewing the film in a theater and visible to someone viewing a copy of the film."

At the outset, as noted above, there is no "enablement" requirement under 35 U.S.C. § 112, first paragraph pertaining to how something works. Furthermore, in any event none of the claims 1-13 or 22-28 recite that "the sequences presented on the screen are invisible to someone viewing the film in a theater and visible to someone viewing a copy of the film." While these benefits may accrue from the claimed invention, they are not specifically recited features of the claimed invention.

Instead, for example, claim 2 merely recites: (1) a light source device for generating a plurality of colored light beams onto the screen concurrently with the images; and (2) a processor for causing the light source to project the colored light beams onto the screen in accordance with a selected scanning sequence, for a finite period of time. An apparatus including such features – the actual features recited in the claim – have been amply described in the Specification so as to enable any one of ordinary skill in the art to make and use the claimed apparatus. Similar reasoning holds with respect to claim 1, and the rest of the claims.

Accordingly, for at least these reasons, Applicants respectfully traverse the rejection of claims 1-13 and 22-28 under 35 U.S.C. § 112, first paragraph.

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35 U.S.C. §§ 102 and 103

The Office Action rejects: claims 1-2, 5-8, 10, 13, 22-23, 25 and 28 under 35 U.S.C. § 102 over Chaum U.S. Patent 5,959,717; claims 3-4 under 35 U.S.C. § 103 over Chaum; claims 9, 11-12 and 24 under 35 U.S.C. § 103 over Chaum in view of either Munich et al. U.S. Patent 5,182,771 or Epstein U.S. Patent 6,529,600; and claims 26-27 under 35 U.S.C. § 103 over Chaum in view of Mead U.S. Patent 5,680,454.

Applicants respectfully traverse those rejections for at least the following reasons.

Epstein Is Not Prior Art For Purposes of 35 U.S.C. § 103

Epstein does not qualify as prior art under 35 U.S.C. § 102(a) or (b), and apparently only qualifies as prior art under 35 U.S.C. § 102(e). However, both the present application and Epstein "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." See 35 U.S.C. § 103(c). This is evidenced by the Assignment of both Epstein and the present application to KONINKLIJKE PHILIPS ELECTRONICS N.V. The Assignment of the present application is recorded at Reel 015995, Frame 0718, while the assignment for Epstein is recorded at Reel 013615, frame 0211.¹

Accordingly, Applicants respectfully request that the Examiner withdraw the rejections of claims 9, 11-12 and 24 under 35 U.S.C. § 103 over Chaum in view of Epstein.

Claim 1

Among other things, the method of claim 1 includes projecting a plurality of colored light beams onto the screen concurrently with the images, in accordance with a selected scanning sequence, for a finite period of time.

Applicants respectfully submit that Chaum does not disclose projecting such a plurality of colored light beams onto a screen in accordance with a selected scanning

¹ The application that became Epstein U.S. Patent 6,529,600 was originally assigned to U.S. Philips Corp. which is a wholly owned subsidiary of KONINKLIJKE PHILIPS ELECTRONICS N.V., before U.S.

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sequence. In particular, Applicants respectfully submit that the cited text at col. 7, lines 31-64 does not disclose projecting such a plurality of colored light beams onto a screen in accordance with a selected scanning sequence. Indeed, the cited text does not even make any mention of a plurality of colored light beams!

Response to Arguments in Advisory Action

The Advisory Action states that projectors 10 and 12 project colored light beams onto a screen.

Claim 1 recites projecting a plurality of colored light beams onto the screen concurrently with the images. Film projector 10 projects the images onto the screen, and does not project any colored light beam concurrently with the images. Meanwhile, it appears that video projector 12 may project a single multicolored light beam onto the screen, but nothing in Chaum discloses that it projects any plurality of beams onto the screen, and certainly not a plurality of colored light beams.

Among other things, the method of claim 1 includes selecting a scanning sequence from a plurality of predetermined scanning sequences.

Applicants do not see anything in the cited text at col. 7 disclosing any plurality of predetermined scanning sequences.

Accordingly, for at least these reasons, Applicants respectfully submit that claim 1 is patentable over Chaum.

Claims 2-8, 10 and 13

Claims 2-8, 10 and 13 depend from Chaum and are deemed patentable for at least the reasons set forth above with respect to Chaum, and the following additional reasons.

Chaum does not disclose scrolling, horizontal scrolling, vertical scrolling, diagonal scrolling, or flashing a plurality of colored light beams onto a screen concurrently with the images, nor does it disclose repeating steps (a) and (b) when a predetermined event occurs. The cited text at col. 7, lines 31-64 and col. 8, lines 51-

Philips Corp. assigned the application to KONINKLIJKE PHILIPS ELECTRONICS N.V.

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54 certainly does not disclose any of these things! Indeed, the cited text does not even make any mention of scrolling any plurality of colored light beams!

Moreover, the Office Action is vague and inconsistent.

On page 5, line 1, the Office Action implies that Chaum discloses horizontal scrolling. Then, at page 5, line 3, the Office Action states that Chaum does not disclose horizontal scrolling. Clarification is respectfully requested.

Furthermore, Applicants traverse the Examiner's Official Notice.

Claims 3 and 4 do not recite scrolling "data" horizontally or vertically. Instead, claims 3-4 recite scrolling colored light beams across a screen horizontally or vertically. Meanwhile, Applicants traverse the statement that "it would have been obvious to one of ordinary skill in the art at the time the invention was [made] to scroll [colored light beams] in a horizontal or vertical fashion because doing so is another means to effectively present an alert to a user." The Examiner is respectfully requested to provide evidence in support of this statement of "Official Notice" pursuant to M.P.E.P. § 2144.03(C). See 37 CFR 1.104(c)(2). See also Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the Examiner is relying on personal knowledge to support the finding of what is known in the art, the Examiner is respectfully requested to provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding). See 37 CFR 1.104(d)(2).

Accordingly, for at least these additional reasons, Applicants respectfully submit that claims 2, 5-8, 10 and 13 are all clearly patentable over Chaum.

Claim 22

Among other things, the apparatus of claim 22 includes a light source device for generating a plurality of colored light beams onto the screen concurrently with the images, and a processor for causing the light source to project the colored light beams onto the screen in accordance with a selected scanning sequence, for a finite period of time.

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As explained above with respect to claim 1, Applicants respectfully submit that Chaum does not disclose a light source device for generating a plurality of colored light beams onto the screen concurrently with the images. In particular, Applicants respectfully submit that the cited text at col. 7, lines 31-64 does not disclose such a light source. Indeed, the cited text does not even make any mention of a plurality of colored light beams!

Accordingly, for at least these reasons, Applicants respectfully submit that claim 2 is patentable over Chaum.

Claims 23, 25 and 28

Claims 23, 25 and 18 depend from Chaum and are deemed patentable for at least the reasons set forth above with respect to Chaum, and the following additional reasons.

Chaum does not disclose a plurality of light-emitting diodes, wherein at least two of the light-emitting diodes produce two different colors, nor does it disclose processor selects a different scanning sequence when a predetermined event occurs. The cited text at col. 7, lines 31-64 certainly does not disclose any of these things! Indeed, the cited text does not even make any mention of scrolling any plurality of colored light beams!

Accordingly, for at least these additional reasons, Applicants respectfully submit that claims 25 and 28 are all clearly patentable over Chaum.

Claims 9, 11-12, and 24

Claims 9, 11 and 12 depend from claim 1, and claim 24 depends from claim 22. Munich does not remedy the shortcomings of Chaum as set forth above with respect to claims 1 and 22, and therefore claims 9, 11-12 and 24 are all deemed patentable over any proper combination of Chaum and Munich for at least the reasons set forth above with respect to claims 1 and 22, and for the following additional reasons.

At the outset, Applicants traverse the statement that Munich "discloses a similar copy protection system" to that disclosed by Chaum. Applicants respectfully ask the Examiner how he believes that Munich's method of varying the number of

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lines in a multiplexed analog component television signal is "similar" to Chaum's method of combining encoding a film with copy protection features and then canceling the visibility of the features on a theater screen by overlaying an appropriate video signal onto the screen? What is similar about those two things at all – other than that both pertain very generally to copy protection?

Applicants respectfully traverse the proposed combination of Chaum and Munich as lacking any suggestion or motivation whatsoever in the prior art. The Office Action provides absolutely no citation to any evidence in support of the proposed motivation in the prior art, nor is an affidavit provided 37 CFR 1.104(d)(2) if the proposed motivation is based upon the Examiner's personal knowledge. Either a citation to something in the prior art supporting the proposed motivation, or such an affidavit under 37 CFR 1.104(d)(2) is respectfully requested, or else it is requested that the rejection be withdrawn.

Finally, the undersigned attorney has reviewed Munich and sees nothing disclosing that a scanning rate of at least one scanning sequence is selected based on a content of the projected image, or that the predetermined event includes an aspect of the content in the image. The Office Action does not cite anything in Munich that supposedly discloses such features. The Examiner is respectfully requested to either provide a citation to something in that Munich that discloses such features, or withdraw the rejections of claims 11, 12 and 24.

Accordingly, for at least these additional reasons, Applicants respectfully submit that claims 9, 11-12 and 24 are patentable over the cited prior art.

Claims 26-27

Claims 26-27 depend from claim 22. Mead does not remedy the shortcomings of Chaum as set forth above with respect to claim 22, and therefore claims 26-27 are all deemed patentable over any proper combination of Chaum and Mead for at least the reasons set forth above with respect to claim 22, and for the following additional reasons.

At the outset, Applicants traverse the statement that Mead "discloses a similar copy protection system" to that disclosed by Chaum. Applicants respectfully ask the

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Examiner how he believes that Mead's method of varying the frame rate of a projected film using a pseudorandom dithering sequence is "similar" to Chaum's method of combining encoding a film with copy protection features and then canceling the visibility of the features on a theater screen by overlaying an appropriate video signal onto the screen? What is similar about those two things at all – other than that both pertain very generally to copy protection of film?

Applicants respectfully traverse the proposed combination of Chaum and Mead as lacking any suggestion or motivation whatsoever in the prior art. The Office Action provides absolutely no citation to any evidence in support of the proposed motivation in the prior art, nor is an affidavit provided 37 CFR 1.104(d)(2) if the proposed motivation is based upon the Examiner's personal knowledge. Either a citation to something in the prior art supporting the proposed motivation, or such an affidavit under 37 CFR 1.104(d)(2), is respectfully requested, or else it is requested that the rejection be withdrawn.

Finally, the undersigned attorney has reviewed Mead and sees nothing disclosing a processor that causes a light source to project colored light beams onto the screen in accordance with a randomly selected scanning rate. Indeed, Applicants do not even see any mention of any plurality of color light beams in Mead. The Office Action does not cite anything in Mead that supposedly discloses such colored light beams, or randomly scanning any plurality of colored light beams. The Examiner is respectfully requested to either provide a citation to something in that Mead that discloses such features, or withdraw the rejections of claims 26-27.

Accordingly, for at least these additional reasons, Applicants respectfully submit that claims 26-27 are patentable over the cited prior art.

NEW CLAIMS 29-35

New claims 29-31 depend variously from claim 1, and new claims 32-35 depend variously from claim 22. Applicants respectfully submit that claims 29-35 are patentable for at least the reasons set forth above with respect to claims 1 and 22 from which they respectively depend, and for the following additional reasons.

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Claims 29 and 32

Claims 29 and 32 each recite that the plurality of colored light beams includes a first light beam having a first color, a second light beam having a second color, and a third light beam having a third color, wherein the first, second, and third colors are all different from each other, and wherein none of the light beams overlap with each other.

Nothing in the cited prior art discloses or suggests such a feature.

Claims 30 and 34

Claims 30 and 34 each recite that the plurality of colored light beams produces a plurality of color bars on the screen, at least three color bars having different colors from each other.

Nothing in the cited prior art discloses or suggests such a feature.

Claims 31 and 35

Claims 31 and 35 each recite that the at least one scanning sequence comprises scrolling separate red, green, and blue color bars scanning across the screen.

Nothing in the cited prior art discloses or suggests such a feature.

Claim 33

Claim 33 recites the selected scanning sequence comprises scrolling the plurality of colored light beams across the screen.

Nothing in the cited prior art discloses or suggests such a feature.

CONCLUSION

In view of the foregoing explanations, Applicants respectfully request that the Examiner reconsider and reexamine the present application, allow claims 1-13 and 22-35, and pass the application to issue. In the event that there are any outstanding matters remaining in the present application, the Examiner is invited to contact Kenneth D. Springer (Reg. No. 39,843) at (571) 283.0720 to discuss these matters.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment (except for the issue fee)

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to Deposit Account No. 50-0238 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17, particularly extension of time fees.

Respectfully submitted,

VOLENTINE FRANCOS & WHITT, P.L.L.C.

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By:


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